

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:

see form PCT/ISA/220

X/16534

PCT

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

19 OCT 2005

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

| | | |
|---------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------|----------------------------------------------|
| Applicant's or agent's file reference see form PCT/ISA/220 | | FOR FURTHER ACTION See paragraph 2 below |
| International application No. PCT/US2004/038233 | International filing date (day/month/year) 08.12.2004 | Priority date (day/month/year) 19.12.2003 |
| International Patent Classification (IPC) or both national classification and IPC C07D405/06, C07D405/14, A61K31/4184, A61K31/454, A61K31/5377 | | |
| Applicant ELI LILLY AND COMPANY | | |

1. This opinion contains indications relating to the following items:

- Box No. I Basis of the opinion
- Box No. II Priority
- Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Box No. IV Lack of unity of invention
- Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- Box No. VI Certain documents cited
- Box No. VII Certain defects in the international application
- Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

| | |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------|
| Name and mailing address of the ISA:  European Patent Office D-80298 Munich Tel: +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465 | Authorized Officer Telephone No. +49 89 2399-  |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------|

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2004/038233

Box No. I Basis of the opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 a sequence listing
 table(s) related to the sequence listing
 - b. format of material:
 in written format
 in computer readable form
 - c. time of filing/furnishing:
 contained in the international application as filed.
 filed together with the international application in computer readable form.
 furnished subsequently to this Authority for the purposes of search.
3. In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2004/038233

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

the entire international application,
 claims Nos. 15-17 (industrial applicability)

because:

the said international application, or the said claims Nos. 15-17 (industrial applicability) relate to the following subject matter which does not require an international preliminary examination (specify):
see separate sheet

the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (specify):

the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.

no international search report has been established for the whole application or for said claims Nos.

the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

| | |
|----------------------------|---------------------------------------------------------------------------------------------------------------|
| the written form | <input type="checkbox"/> has not been furnished <input type="checkbox"/> does not comply with the standard |
| the computer readable form | <input type="checkbox"/> has not been furnished <input type="checkbox"/> does not comply with the standard |

the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-bis of the Administrative Instructions.

See separate sheet for further details

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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2004/038233

**Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or
industrial applicability; citations and explanations supporting such statement**

1. Statement

| | | |
|-------------------------------|-------------|------------|
| Novelty (N) | Yes: Claims | 1-19 |
| | No: Claims | |
| Inventive step (IS) | Yes: Claims | 1-19 |
| | No: Claims | |
| Industrial applicability (IA) | Yes: Claims | 1-14,18,19 |
| | No: Claims | |

2. Citations and explanations

see separate sheet

Box No. VI Certain documents cited

1. Certain published documents (Rules 43bis.1 and 70.10)
and / or
2. Non-written disclosures (Rules 43bis.1 and 70.9)

see form 210

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Re Item III

Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

Claims 15-17 relate to subject matter considered by this Authority to be covered by the provisions of Rule 67.1 (iv) PCT. Consequently, no opinion will be formulated with respect to the industrial applicability of the subject matter of these claims, cf. Article 34(4)(a)(i) PCT.

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1-Reference is made to the following documents:

d1: WO2004052847

d2: WO03078394

d3: WO03053358

2- Novelty

Present compounds of formula (I) are novel vis-à-vis d2 and d3 at least on account of the tricyclic ring system.

Hence, the requirements of art. 33.2 PCT are met.

3- Inventive step

3.1- The applicant has set himself the task of providing novel modulators of the steroid hormone nuclear receptors.

Documents d2 and d3 relate to heterocyclic compounds having the same use of present compounds. Considering the chemical structures of the compounds disclosed in these documents, it appears that any of the two can be regarded as the closest prior art.

The data disclosed in Table 1 of the application provide the evidence that the compounds of formula (I) indeed posses the claimed activity. Hence, the objective technical problem can be formulated as the provision of further modulators of the steroid hormone nuclear receptors.

3.2- Neither d1 nor d2 suggest that dibenzocycloheptan or dibenzoxxepin derivatives

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING
AUTHORITY (SEPARATE SHEET)**

International application No.

PCT/US2004/038233

could be used as modulators of the steroid nuclear hormone receptors. Accordingly, the requirements of Art. 33.3 are met.

Re Item VI

Certain documents cited

d1: WO2004052847

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